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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,410	08/25/2003	Michael D. Kotzin	CS23254RA	2657

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EXAMINER	
STEIN, JULIE E	

ART UNIT	PAPER NUMBER
2688	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/647,410	KOTZIN ET AL.	
	Examiner	Art Unit	
	Julie E. Stein, Esq.	2688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5 and 7-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 19 recites that negotiating with the radio communications network occurs without making a handover decision, but the specification on page 7 clearly states that negotiation only occurs after a determination has been made that handover will occur. See page 7, lines 4 to 11. Therefore, claim 19 contains new matter.

3. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 19 recites, as indicated above, that negotiating with the radio communications network occurs without making a handover decision, but the specification on page 7 clearly states that negotiation only occurs after a determination has been made that

handover will occur. See page 7, lines 4 to 11. Therefore, claim 19 is not enabled by the specification in such a way as to allow one of ordinary skill in the art to make and/or use the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 7-9, 10-12, and 14-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0082018 to Coskun et al. (Coskun has now issued as U.S. Patent No. 6,944,452, however all cites in the current rejection have been maintained to cite to the publication for purposes of continuity.)

Coskun discloses all the steps of independent 1, including a method in a mobile communications device (28), the method comprising: participating in a packet session (paragraph 22); identifying a handover target in the mobile communications device (paragraph 37, MT 28 identifies a new pilot signal of sector $\beta_{1,2}$); sending handover information for the handover target to a packet server (HM/PSM 34) while in the packet session (Figure 3 and paragraph 37); receiving radio resource information from the packet server in response to sending the handover information to the packet server (Figure 3 and paragraph 42).

Coskun discloses all the steps of claim 2, including handing over to the handover target using the radio resource information received from the packet server. See paragraph 42.

Coskun discloses all the steps of claim 3, including handing over to the handover target without requiring the mobile communications device to request a radio resource assignment from the new cell (paragraph 42 and Figure 3).

Coskun discloses all the steps of claim 4, including receiving radio resource information from the packet server in response to sending handover information to the packet server includes receiving at least one of frequency, slot, time-to-transfer and power information from the packet server. See paragraph 42, which informs the MT of its new channels.

Coskun discloses all the steps of claim 5, including making neighbor measurements during the packet session (paragraph 37); sending the handover information to the packet server includes sending information based on the neighbor measurements (Id.).

Coskun discloses all the steps of claim 7, including participating in the packet session includes communicating voice data in the packet session (paragraph 70, VoIP); sending the handover information to the packet server while communicating voice data in the packet session (Id.).

Coskun discloses all the steps of claim 9, including reducing interruption of the packet session during handover by using the radio resource information received from

the packet server to facilitate handover to a new cell. See paragraph 4 identifying interruption as a problem, therefore reduction is inherent to the disclosed method.

The rejections of claims 1-9 are hereby incorporated. Coskun discloses all the steps of independent claim 10, including a method in a packet server (Figure 3, element 34) connected to a communications network (Figure 3), the method comprising: receiving information from a mobile wireless communications device (MT 28) identifying a handover target (paragraph 37); negotiating with a radio communications network (paragraph 25) for a radio resource transfer for the handover target identified by the mobile wireless communications device (MT 28) (paragraphs 38 to 42), sending, from the packet server (element 34), radio resource information for the handover target identified to the mobile wireless communications device (MT 28) (Figure 3 and paragraph 42).

Coskun discloses all the steps of claim 11, including sending the radio resource information to the mobile wireless communications device after negotiating in response to receiving the handover information (Figure 3 and paragraph 42).

Coskun discloses all the steps of claim 12, including negotiating with the radio communications network for a radio resource transfer for the mobile wireless communications device based on the handover information received from the mobile wireless communications device. See paragraphs 37 to 42.

Coskun discloses all the steps of claim 14, including sending radio resource information from the packet data server includes sending at least one of frequency, slot,

time-to-transfer and power information to the mobile wireless communications device. See paragraph 42, which informs the MT of its new channels.

The rejections of claims 1-14 are hereby incorporated. Coskun discloses all the steps of independent claim 15, including a method in a mobile communications device in a packet session (see above), the method comprising: deciding to handover to a target cell (paragraph 37, the MT 28 identifies and thus decides to handover); sending handover information for the target cell to a packet server during a packet session (Id.); receiving radio resource information from the packet server (see above) for the target cell before handing over to the target cell (paragraph 42).

Coskun discloses all the steps of claim 16, including participating in voice communications in the packet session. See above.

Coskun discloses all the steps of claim 17, including receiving radio resource information from the packet server includes receiving handover timing information, reducing interruption of data communications during the packet session during hand over by making a timed transfer to the target cell using the handover timing information from the packet server. This is inherent based on paragraph 42 and the MT using the new assigned channels to begin listening to the DSC and DTC and then to send an HO complete message. In addition, Figure 4 and its corresponding description, which discloses using a dormant mode and timing to complete a handover is also an example of using timing in the handover.

Coskun discloses all the steps of claim 18, including making a handover decision in the mobile communications device. See paragraph 37, wherein the MT 28 identifies the sector that has sufficient pilot signal strength for call processing.

Coskun discloses all the steps of claim 19, including negotiating with the radio communications network without making a handover decision for the mobile wireless communications device. As this claim has been rejected above as containing new matter, the Examiner is interpreting the claim to require that a decision regarding handover had to have been made at some point in order for the negotiating to occur. Therefore, the sending of the pilot signal information by the MT in paragraph 37 and the further computing and detecting of the message by HM/PSM 34 in paragraph 38 is being interpreted as a whole to relate to the MT making the handover decision and the HM/PSM simply detecting and interpreting said decision. Therefore, the further negotiating disclosed in paragraphs 39 to 41 follow the handover decision and thus the negotiating is done "without" making a handover decision for the mobile wireless communications device.

The rejections of claims 1-19 are hereby incorporated. Coskun discloses all the steps of independent claim 20, including a method in a wireless communications network entity (Figure 3, element 30), the method comprising: receiving handover information from a mobile wireless communications deice (MT 28) identifying a potential handover target (paragraph 37 to 38); communicating handover information to the potential handover target (paragraph 39, element RAP224) before the mobile wireless communications device handsover to the potential handover target (paragraph 42).

Coskun discloses all the steps of claim 21, including sending, from the wireless communications network entity, radio resource information for the potential handover target to the mobile wireless communications device before the wireless communication device hands over to the potential handover target. See paragraph 42.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coskun.

Coskun discloses all the steps of claim 8, including, receiving radio resource information from the packet server for at least one of the handover targets identified (paragraphs 37, (sector $\beta_{1,2}$) and 42). However, Coskun does not explicitly teach that identifying a plurality of potential handover targets to the packet server. But one of ordinary skill in the art at the time the invention was made would have understood that if the mobile terminal 28 could identify one sector (sector $\beta_{1,2}$) or handover target then it could identify multiple sectors or targets. See MPEP 2104.44.

Coskun discloses all the steps of claim 13, including sending radio resource information to the mobile wireless communications device for at least one of the handover targets identified by the mobile wireless communications device (paragraph 42). However, Coskun does not explicitly teach that receiving handover information from

the mobile wireless communications device includes receiving a plurality of handover targets identified by the mobile wireless communications device. But, one of ordinary skill in the art at the time the invention was made would have understood that if the mobile terminal 28 could identify one sector (sector $\beta_{1,2}$) or handover target then it could identify multiple sectors or targets. See MPEP 2104.44.

Response to Arguments

8. Applicant's arguments filed October 27, 2005 have been fully considered but they are not persuasive.

9. Applicant's first argument regards claim one and whether the mobile terminal identifies a handover target. MT 28 clearly identifies a handover target in paragraph 37 as indicated above. In addition, Applicant acknowledges that the HM/PSM 34 of Coskun receives PSM or pilot signal measurements from the MT on page 8 of their response. Therefore, as the claim merely requires identification of a handover target, Coskun meets this limitation in combination with the other recitations of the claim.

10. As to dependent claim 8, MPEP section 2104.44 clearly indicates simply requiring a plurality of something does not patentably distinguish the claim over the prior art.

11. Regarding the arguments concerning claims 10, 13, 15, 18, and 20, as they repeat the above two arguments, please see the above responses.

12. As to claim 19, the Examiner has rejected this claim as containing new matter. The specification requires that prior to negotiating with the radio communications network, a handover decision be made and be made positively. Claim 19 appears to

require the exact opposite. The Examiner's interpretation in light of this and reasoning for citing Coskun are explained in the above rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JES

George Eng

GEORGE ENG
SUPERVISORY PATENT EXAMINER